

REMARKS

In the Office Action mailed October 30, 2007, the Examiner rejected claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2002/0161779 to Brierley et al. (hereinafter, "*Brierley*").

By this response, Applicants have amended claims 1-7, 12, 16-20, 22-25, 28, 30, 34, 37, 38, 40-43, 46, 48, 52, and 58. Claims 9, 13, 27, 31, 45, and 49 were previously canceled. No new matter has been added. Accordingly, claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58 are currently pending.

In light of the foregoing amendments and based on the reasoning presented below, Applicants respectfully traverse the rejection of claims under 35 U.S.C. § 102(e), and request the allowance of pending claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58.

I. Rejection of Independent Claims 12, 16, 30, 34, 48, and 52 is Legally Deficient

As a preliminary matter, Applicants respectfully note that while the Office Action states that “[c]laims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58 are rejected . . . by [*Brierley*],” the Office Action only addresses the recitations of independent claims 1, 19, and 37, and their corresponding dependent claims, neglecting to address the specific recitations of the other independent claims. Specifically, the Office Action neglects to address the recitations of independent claims 12, 16, 30, 34, 48, and 52, which are of different scope than that of amended independent claims 1, 19, and 37.

According to the *M.P.E.P.*, the long-established principle of compact prosecution requires that the prosecution of a patent application be brought to conclusion as promptly as possible. *M.P.E.P.* § 706.07. Under this principle, the Examiner should thoroughly search for references pertinent to the subject matter disclosed and claimed in the patent application and fully apply the references in the first Office Action such that Applicants have an opportunity to fully address all the prior art references in reply to the first Office Action and, if necessary, to amend the application to avoid all grounds of rejections. *Id.*

In the present Office Action, the Office Action purports to apply *Brierley* to the recitations of each of the independent claims. However, in actuality, the Office Action only applies *Brierley* to independent claims 1, 19, and 37, leaving the recitations of independent claims 12, 16, 30, 34, 48, and 52, as well as their corresponding dependent claims, unaddressed. This deprives Applicants of their opportunity to fully

address the application of the *Brierley* reference with respect to claims 12-18, 30, 32-36, 48, 50-52, 55 and 57.

Accordingly, because the rejection of these claims is legally deficient, Applicants respectfully request a new Non-Final Office Action which addresses the recitations of claims 12-18, 30, 32-36, 48, 50-52, 55 and 57.

II. Claim Rejections Under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 1-8, 10-12, 14-26, 28-30, 32-44, 46-48, and 50-58 under 35 U.S.C. § 102(e) as anticipated by *Brierley*. A proper anticipation rejection requires that “each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” *M.P.E.P.* § 2131. In addition, “[t]he elements must be arranged as required by the claim” *Id.* (emphasis added). Applicants respectfully submit that *Brierley* fails to disclose all of the subject matter recited in each of the independent claims 1, 12, 16, 19, 30, 34, 37, 48, and 52, and also fails to disclose the elements as arranged by the claims.¹

Brierley fails to disclose, *inter alia*, “modifying one or more financial terms of the offer based on the collected information and [a] response” and “presenting the modified offer to [] at least one of the set of users,” as recited in amended independent claim 1. Instead, *Brierley* discloses “a method for populating and analyzing a member consumer profile database for implementing an incentive driven targeted product marketing program.” *Brierley*, ¶ [0024]. *Brierley* states that “a member consumer 14 may access

¹ Despite the failure of the Office Action to properly apply *Brierley* to each of the independent claims, Applicants address herein each of the claims with respect to the *Brierley* reference.

a predetermined website . . . [and] request[] [an] invitation from the sponsor/advertiser 16 or directly from the promotion operator 18.” *Id.* at ¶ [0035]. “[T]he consumer 14 is notified of his approval to enroll (if so approved).” *Id.* at ¶ [0038]. “The approval may have associated with it an invitation code . . . [and] a link to a registration website may be provided” *Id.*

The Examiner cites to paragraphs 0032, 0056, 0060, and 0062 of *Brierley* as “teach[ing] . . . modifying the offer based on the collected information” Office Action, pp. 2-3. According to *Brierley*, “[t]he profile enrichment process 326 interacts with the member consumer 14 in multiple occurrences provided by the promotion.” *Brierley* at ¶ [0062]. “[T]he profile enrichment process 326 includes at least four processes that may be used to enrich the profile database 30.” *Id.* at ¶ [0063]. These processes include “a dynamic personal profile enrichment process 330,” a “behavioral analysis process 331,” “a promotion result verification process 332,” and “a periodic profile updating process 334.” *Id.*

However, *Brierley* discloses that the method may be used for “evaluating the present promotion and for designing better promotions in the future.” *Id.* at ¶ [0056] (emphasis added). *Brierley* does not disclose, *inter alia*, “modifying one or more financial terms of the offer based on the collected information and [a] response” and “presenting the modified offer to [] at least one of the set of users,” as recited in amended independent claim 1.

Accordingly, for at least the above-outlined reasons, *Brierley* fails to disclose all of the subject matter recited in Applicants’ amended independent claim 1. Therefore,

the rejection of amended independent claim 1 under 35 U.S.C. § 102(e) is legally deficient, should be withdrawn, and the claim allowed.

Claims 12, 16, 19, 30, 34, 37, 48, and 52, although of different scope, include, *inter alia*, recitations similar to those of amended independent claim 1. As discussed above, the rejection of claim 1 under 35 U.S.C. § 102(e) is legally deficient. Accordingly, for at least the same reason set forth above in connection with claim 1, the rejection of claims 12, 16, 19, 30, 34, 37, 48, and 52 is also legally deficient, should be withdrawn, and the claims allowed.

Claims 2-8, 10-11, and 54 depend from amended independent claim 1. Claims 14-15 and 58 depend from amended independent claim 12. Claims 17-18 and 55 depend from amended independent claim 16. Claims 20-26, 28-29, and 56 depend from amended independent claim 19. Claims 32 and 33 depend from amended independent claim 30. Claims 35-36 and 57 depend from amended independent claim 34. Claims 38-44 and 46-47 depend from amended independent claim 37. Claims 50 and 51 depend from amended independent claim 48. Claim 53 depends from amended independent claim 52. As discussed above, *Brierley* does not support a rejection of independent claims 1, 12, 16, 19, 30, 34, 37, 48, and 52. Therefore, dependent claims 2-8, 10-11, 14-15, 17-18, 20-26, 28-29, 32, 33, 35, 36, 38-44, 46, 47, 50, 51, and 53-58 are allowable for at least the same reasons as set forth above in connection with their corresponding amended independent claims.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: January 30, 2008

By: _____

A handwritten signature in black ink, appearing to read 'Joseph E. Palys', is written over a horizontal line.

Joseph E. Palys
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